IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REMARKS

Initially, Applicant has amended claim 25 to correct the lack of proper antecedent basis and more accurately reflect the present invention. Additionally, Applicant has amended claim 3 to more accurately reflect the invention. This amendment is not for any reason related to patentability; no new matter has been added. Applicant believes that the amended claim and the following comments will convince the Examiner that the rejections set forth in the January 13, 2004 Office Action have been overcome and should be withdrawn.

I. THE INVENTION

Generally, the present invention conveys presence information of a calling party to a called party through the use of voice mail left by the calling party. When a called party retrieves a voice mail message, the present invention determines if the party who left the message is currently present (at the caller's telephone) and potentially available for a return call. A user of the system obtaining presence information can then decide whether to return the call or wait until the party who left the voice mail message becomes available. The present

invention further discloses the use of a presence server that determines the likely availability of a calling party who has left a voice message for a called party. For example, if the presence server determines that the calling party is currently on the telephone, the presence server may conclude that the calling party is present, but unavailable to accept a return call.

II. THE EXAMINER'S REJECTIONS

The Examiner deemed the reply filed on March 3, 2003 unresponsive for several reasons. First, newly added Claim 25 lacks antecedent basis. In addition, newly added Claim 25 fails to point out and distinctly claim the subject matter which the Applicant regards as his invention. Further, Claim 25 appears to be incomplete to the Examiner and lacks explanation in the response.

III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

Applicant has amended Claim 25 to correct the lack of proper antecedent basis as well as other problems under 35 USC § 112, second paragraph. Applicant has also provided an explanation for the addition of Claim 25 below. Applicant respectfully requests reconsideration of Claims 1-16, 18, 19, and 22-25 in light of the

abovementioned amendment and the arguments filed on March 31, 2003, which the Examiner deemed not fully-responsive. The rejections set forth in the December 31, 2002 Office Action and the arguments submitted in response to the December 31, 2002 Office Action on March 31, 2003 are incorporated below for the Examiner's convenience.

A. 35 U.S.C. § 112, ¶2

Claims 1-5 and 7-19 were rejected under 35 U.S.C. § 112, ¶2 for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention.

The December 31, 2002 Office Action objected to the use of the term "availability information" and "use of a voice mail message" with respect to Claim 1. Office Action dated December 31, 2002 page 2. Claim 1 has been amended to recite that the system is to provide presence information. Claim 1 has also been amended to delete the reference to using a voice mail message. Accordingly, amended Claim 1 obviates the rejection raised in the December 31, 2002 Office Action.

The December 31, 2002 Office Action further objected to Claims 7-8 and Claim 14 for "similar confusion" with respect to "the relationship or non-relationship of the presence and

availability information." Office Action dated December 31, 2002 page 2. Applicant respectfully submits that the terms are distinct as defined by the figures and specification of the present application. Applicant would like to direct the Examiner's attention to Figure 3. Figure 2 clearly labels "availability information" as element 216 and "presence indication" as element 204. Claim 7 recites a method of providing "availability information" which is accomplished by the method comprising "receiving availability information" and "including the availability information in [a] voice mail message." Dependent claim 8 adds the step of "determining the presence of the calling party." The terms "availability" and "presence" are distinct and not used interchangeably, and the claims set forth steps as to how the use is practiced. Accordingly, the December 31, 2002 Office Action's rejection of claims 7 and 8 under 35 U.S.C. § 112, ¶2 is respectfully traversed.

Claim 14 recites a method of providing "presence" information which is accomplished by the method comprising "receiving presence information" and "associating the presence information with the calling party." Again, the terms "availability" and "presence" are distinct and not used

interchangeably in Claim 14, and the claim sets forth steps as to how the use is practiced. Accordingly, the December 31, 2002 Office Action's rejection of claim 14 under 35 U.S.C. § 112, ¶2 is also respectfully traversed.

Accordingly, it is respectfully submitted that claims 1-5 and 7-19, as amended meet the requirements of 35 U.S.C. § 112, ¶2.

B. 35 U.S.C. 102(b)

The December 31, 2002 Office Action rejected claims 6, 14-16, 18-19 and 22 under 35 U.S.C. § 102(b) as being anticipated under U.S. Patent No. 5,625,682 to Gray *et al.* ("Gray").

In order to anticipate a claim, a single reference must be valid under 35 USC §102 with respect to its critical date and it must teach every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987); see also MPEP §2131. Applicants contend that the prior art references cited by the Examiner in the Office Action do not teach each and every element of the claims in the present invention.

Gray describes receiving a voice mail message and a callback phone number from a calling party (Gray, col. 3, ll. 47-64) and

routing the voice mail message and callback phone number to an agent when the agent becomes free (Gray, col. 6, ll. 1-2). However, Gray does not teach or disclose providing presence information associated with a voice mail message which indicates that said calling party is likely to be present as required by claims 6, 14-16, and 18-19. Likewise, Gray does not teach or disclose providing availability information which indicates whether the calling party is likely to be present at an available telephone as required by amended claim 22. Accordingly, amended claims 6, 14-16, 18-19 and 22 are patentable over Gray because Gray does not contain each and every claim limitation of the present application.

Claims 1-5 and 7-13 are patentable, *inter alia*, by virtue of the reasons stated above with respect to claims 6, 14-16, 18-19 and 22.

C. Other Amendments

Claim 23 has been drafted in independent form incorporating all of the limitations of claim 22 and is patentable for the reasons set forth in the December 31, 2002 Office Action, paragraph 7. New independent claim 24, similar to claim 23, is also patentable for the reasons set forth with respect to claim

23.

New independent claim 25 has been added to incorporate the limitations of original claim 17 and claim 14 dependant thereon and is patentable for the reasons set forth in paragraph 7 of the December 31, 2002 Office Action. Claims 1-16, 18, 19, and 22-25 are in condition for allowance.

Respectfully submitted,

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